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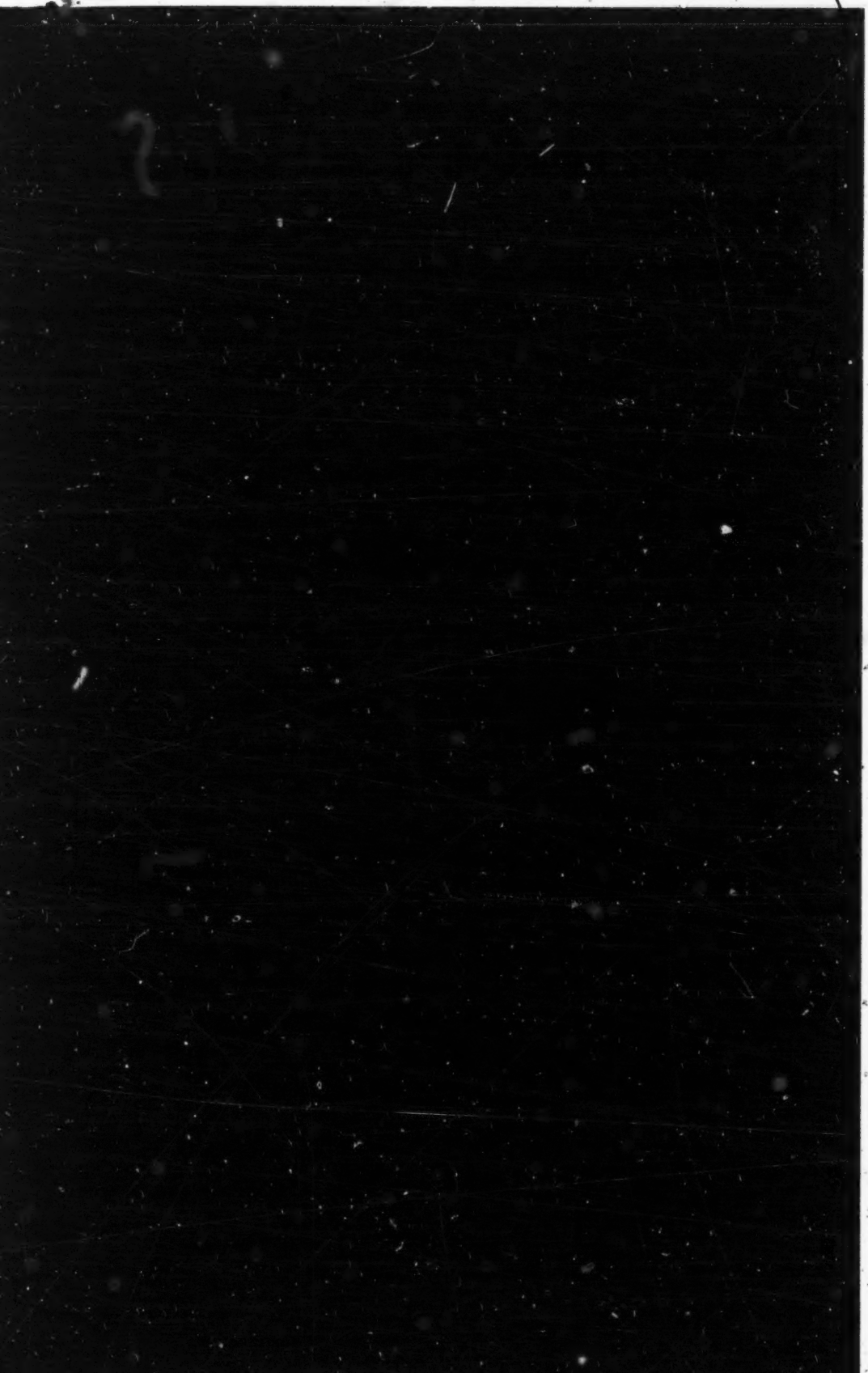

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Furthermore, a mere provision of relief in these pistons would be insufficient, for even then the relief must be read into the cancelled claims *nunc pro tunc* and, if so, the claims would still not be coextensive with the allowed claims.

(2) Questions of file wrapper estoppel, construction of claims in the *file wrapper*, or the abandonment of claims in the file wrapper are not involved. The question involved is estoppel, construction or abandonment based upon *an interference record*. What was done with respect to the cancelled claims relied upon by this Court does not appear in the file wrapper. It does appear in the interference record. It is well recognized that where the file wrapper is resorted to for these various purposes what was done and said in the file wrapper are relied upon to ascertain the extent of the estoppel, what was abandoned or the construction of the claim. *Whatever was said about and done with respect to the cancelled claims relied upon by this Court appears in the interference record and not in the file wrapper.* No estoppel, construction or abandonment based on the interference record was pleaded and there is no evidence on this question before the Court. There was no occasion to present the evidence because that question was never considered until this Court took it up voluntarily after the arguments and briefs had been submitted in these causes.

(3) Estoppel, claim construction or abandonment predicated upon either file wrapper or interference record does not relate to single elements, but to the questions of the right to "revive" claims which have been cancelled or abandoned. All decisions on the questions are to this effect, including this Court's decision in *Altoona v. Tri-Ergon*, written by Mr. Justice Stone.

(4) The Court of Appeals stressed the retracted bosses just as much as the flexible webs.

(5) Even if relief were supplied to the pistons of Long, Spillman and Hartog, they would not operate like

Jardine or solve the problem which he solved. Indeed, each one would be inoperative and quick to destroy the engine.

(6) Without considering the disclosures of Long and Spillman, the interference counts are given a technical claim consideration. Only by considering the disclosures of Long and Spillman are they given an embodied invention interpretation.

(7) While a claim may be interpreted in the light of the specification to include the property of an element, structure may not be read into the claim. There is no inconsistency in these two positions.

(8) The evidence shows that the allowed claims are patentable in view of the cancelled claims. There is no evidence to challenge this proposition. It has first been asserted in the Petitioners' Brief on our Motions to Remand and Petition for Rehearing.

(9) Our positions have not been shifted except that we are not here urging matters which this Court decided against us. For example, we are not asking this Court to hold that the webs of Gulick are flexible; it is our adversaries who ask that.

File Wrapper Estoppel as stated by petitioners at pages 2 and 3 of their brief is, of course, not the law. Particularly is it not the law that the patentee will not

> "be permitted to change the scope of that claim in order to make out a case of either infringement or valdity."

The law is that the patentee, having surrendered a claim as a condition of the grant, may not recapture or revive the claim that was thus surrendered and abandoned, by resort either to the doctrine of construction or equivalency. The law was so stated in the decisions relied upon by the petitioners. For example, in *Altoona v. Tri-Ergon*, 294 U. S. 477, 492, 493, this Court, speaking through Mr. Justice

Stone, stated the rule as follows:

> "Nor can an interpretation be given the allowed claims which would *revive the claims* which were abandoned in order to obtain the patent. *Shepard v. Carrigan,* 116 U. S. 593, 597; *Roemer v. Peddie,* 132 U. S. 313, 317; *Royer v. Coupe,* 146 U. S. 524, 532; *Corbin Cabinet Lock Co. v. Eagle Lock Co.,* 150 U. S. 38, 40; *Morgan Envelope Co. v. Albany Paper Co.,* 152 U. S. 425, 429; *I. T. S. Rubber Co. v. Essex Rubber Co.,* 272 U. S. 429, 443; *Smith v. Magic City Club,* 282 U. S. 784, 789, 790; *Smith v. Snow, supra.*"

There is a far cry between construing a claim in the light of the specification without trying to revive a cancelled claim, and undertaking to construe the allowed claim for the purpose of reviving the cancelled claim. In the instant causes we have shown that the claim which was cancelled was not the same, and could not have been the same, as the allowed claim, and that we are not seeking to revive something that was cancelled. The error of the Court was in giving to the cancelled claim a construction which it could not have had and doing this in order to make out a case of claim revival.

In *I. T. S. v. Essex* the rule was stated by this Court (272 U. S. 444) as follows:

> "So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he 'may not by construction, or by resort to the doctrine of equivalents, *give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer.' Weber Elec. Co. v. Freeman Elec. Co.,* 256 U. S. 668, 677."

Here again we have the statement that the allowed claim may not be construed so as to recapture the claim which was abandoned or be given the same scope as the claim that was cancelled or amended. There was no forbidding of a

construction of the allowed claim either to make out infringement or avoid invalidity as long as it was not such as to recapture what had been surrendered as a condition of the grant.

A close examination of the other cases relied upon by the petitioners and cited by this Court in these decisions will show that no Court has ever stated the rule as petitioners have stated it, but that it has always been stated and applied as we have stated it. The difference between the instant case and the cited cases are: we are not seeking here to recapture or revive what was cancelled. The affidavits of Robertson and Watts show that this could not be so.

The Features Stressed by this Court (Petitioners' Brief, pp. 5-7): In this discussion this Court is asked to violate the cardinal rule of patent law that a new combination of old elements is patentable where there is a meritorious result achieved. Petitioners thus depart from the issues decided by this Court and turn to the question of patentability which this Court specifically said it was not deciding (p. 9 of the decision).* Assuming that what might be broadly called a "relief" is old in pistons, not only is the Jardine combination employing relief as one of its elements new, but the use of Jardine's particular kind of relief for his purpose was new. In Jardine's combination, as in no other combination, the expanding head, to which the most heat is applied, moved the center of the web outward at the same time that its ends were retained by contact relation with the cylinder walls. This resulted in a distortion of the webs so as to bend them as fast as they expanded in length, thus absorbing the expansion in the bending. The particular kind of relief that Jardine em-

* And which it can not consider without overruling *General Pictures v. General Electric*, 304 U. S. 175, at pp. 177, 178; *Connecticut Ry. v. Palmer*, 305 U. S. 493, at p. 496; *Crown Cork v. Gutman*, 304 U. S. 159, at p. 161; and numerous cases earlier and later.

ployed in the particular place where it was employed contributed materially to this operation. Indeed, it was essential to the operation, just as the web, capable of being distorted and flexed, was also essential to this operation. Of course, all of the other elements of the combination were just as essential as the web, the web flexibility, and the so-called relief. No one element is any more essential or any more constitutes the main point and gist of the invention than any of the other elements. Remove any of them and the operation will not be realized.

The "balanced skirt flexibility" read into the claim by this Court is a result. It need not be recited in the claims and, as we have said, it was error to read it into the interference counts. With this proposition our adversaries agree. It was improper to read it into the claims of such applications as Long and Spillman who did not provide a combination for achieving the result of "balanced skirt flexibility" and, while it might be permissible under the opinions of this Court to read into the Jardine allowed claims a result capable of being achieved by the combination of elements recited in the claim, and by the Jardine disclosure, it would be highly improper to read it into a claim which not only did not recite the structure which would perform that function of "balanced skirt flexibility," but which, when read upon such constructions as Long and Spillman, as it must be read, would be interpreted as having a property or function which neither one of these could perform. That is where the mistake has been made, as shown by the affidavits of Robertson and Watts.

It follows from the discussion by both parties that the Court has read into the cancelled claim not only features of structure, but features of operations and results which were not only not possessed, but could not be performed, by such pistons as Long and Spillman, upon which the claims must read, by the imperative rule of construction. Therefore, not only is there a violation of the letter of the claims and claim reading, but of the substance of construc-

tion and operation. All of this is clear from the petitioners' resort to the claim that the element which this Court read into the claims was old in other pistons and to the claim that it is improper to read a feature of operation like "balanced skirt flexibility" into a claim.

The rule that a new combination of old elements is patentable where it achieves such results as "balanced skirt flexibility," the maintenance of minute clearances, etc., etc., which we have described in our discussions on the question of patentability in our Main Brief, is established by decisions of this Court ancient, intermediate, and current. The statement by this Court in *Expanded Metal v. Bradford* on this subject is typical of these cases. It is as follows (214 U. S. 366, 381):

> "It is perfectly well settled that a new combination of elements, old in themselves, but which produce a new and useful result, entitles the inventor to the protection of a patent. *Loom Company v. Higgins,* 105 U. S. 580-591."

The operation of the Jardine piston through the combination, including the particular kind of relief which Jardine employed, is illustrated in Fig. F below:

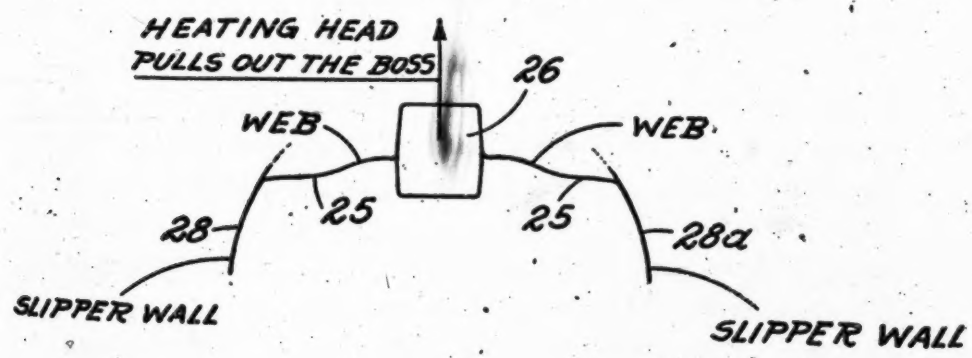

Fig. F

The head, of course, gets hottest because it is right under the flame. Consequently, the head expands outwardly, pulling the boss with it, as indicated by the legend on the drawing. The skirts contact through the oil film, the cylinder wall at the places where the web 25 joined them. This retards the ends of the webs with the result that they are distorted or bowed as indicated in Fig. F. This bowing compensates for the expansion; that is, as an aluminum web tends to expand longitudinally to increase its length, it is bent to shorten its length. Thus, the piston constitutes a heat engine which causes the piston to do the opposite from what nature would make it do. The specification of the Jardine patent describes this method of operation (see, for example, page 2, ll. 22-34). Of course, under well established authority, this operation is not required to be disclosed in the claim to make it patentable any more than the "balanced skirt flexibility," both being features of operations and results.

The Practice in Interferences (Petitioners' Brief, pp. 7 and 8): We find no denial of the practices as set forth in the affidavits we have filed, or as we have stated the practice. It is not denied that the count in an interference must be given the broadest interpretation its language will bear or that it must be read on the disclosures of all of the parties to the interference. It is contended that we are dealing with words, and that the interferences deal with tangibles. Nothing could be more tangible than the disclosures of the other parties to the interferences, such as those of Long and Spillman, which we have illustrated in the back of our Motions to Remand, and which were referred to in the affidavits. It is with these disclosures that we have dealt. It is true, as the Court of Appeals in the District of Columbia said in the *Dement* case cited by the Petitioners, that the contest is over "an embodied invention" and not "a technical claim." That is the reason

why this Court's decision is erroneous. A consideration of the cancelled claims without considering the disclosures of such parties as Long and Spillman, was a consideration of the claim as a "technical claim" or a group of words apart from the structures or "embodied inventions" upon which the claim was read and must have been read in its consideration in the Patent Office at the time it was cancelled.

Petitioners are then driven to asking this Court to read into the Long and Spillman disclosures a feature of structure, i.e., the reliefs. Not only is this violative of all the decisions of this Court, including the first decision of this Court in this litigation, but it would not help the situation if it were done, for the question here is not what somebody by arbitrary edict might read into Long or Spillman, but what construction was given the cancelled claims at the time they were cancelled; and regardless of what is done now, no relief was read into either Long or Spillman at the time the cancelled claims were made, prosecuted and cancelled.

The enormity of the offense which petitioners ask this Court to resort to, becomes apparent when it is remembered that this Court refused to construe a property, such as "flexible" into a patent disclosing a web which all experts agreed was flexible, yet this Court is asked to read into the Long and Spillman disclosures a feature of structure, i.e., "relief," which everybody admits, and which anybody, even a tyro, can see is not disclosed in the structure of either Long or Spillman and cannot be read into them without taking the Long and Spillman pistons out of their patents, changing them and putting them back. If this were permissible there would be no novelty in anything, because a Court could always take an old device and change it so as to make it the same as the novel device. We would thus have a rule of thumb which would defeat all novelty. There would then, of course, never be anything that was new.

These propositions are so wrong that they have seldom, if ever, been presented before. However, such decisions by this Court as *Topliff v. Topliff*, 145 U. S. 161, show that this Court will not entertain such a proposition.

The statement at the bottom of page 8 of Petitioners' Brief that "all pistons had reliefs in the region of their bosses long before Jardine" is wrong. For example, the pistons of Long and Spillman to which we have referred, did not have relief; neither did Hartog, also involved in the interference; neither did the trunk type of piston which was the almost universally used piston prior to Jardine. Neither did many of the pistons of the prior art in this case such as the Long piston (R. p. 709); Stellmann (R. p. 721); Van Bever (R. p. 590). Some such pistons did and some such pistons did not, but those which did only show that the particular element was old. None of them had the Jardine combination or were capable of the operations shown in Figure F above, or of the "balanced skirt flexibility," the maintenance of the minute clearance, or any of the other achievements of Jardine.

Interferences with Gulick (Petitioners' Brief, pp. 9-10): This discussion is also an attack upon the validity of Jardine; it is predicated upon this Court's blowing hot and blowing cold on the interpretation of Gulick, giving it one interpretation for the purpose of a patent in suit, as the Court did in its first decision, and giving it a second and different interpretation in this cause as a prior art reference.

We discussed this in our Main Brief (pp. 24 to 26). The statement at the top of page 10 that "balanced skirt flexibility" was found in all of the claims which Jardine lost in the interferences is simply not true. The evidence shows that not only is it not true, but that it could not have been true because the feature was not possessed by such

pistons as Long and Spillman. In other words, in order to make good the errors which will have been made, there will be a plural violation of the law and the facts; first, reliefs will be read into the Long and Spillman patents when they were not there; second, these reliefs will be Jardine's relief; third, the Jardine reliefs will be read into the claims which were cancelled when they were not there and, then, as a result of these things, "balanced skirt flexibility" will be read into the counts when it was not there, and after all of this is done Jardine will be presumed to have abandoned a claim thus reconstructed, and read upon the Long and Spillman pistons which have been thus reconstructed. We do not know that any court in a patent case was ever asked to run amuck to such a degree.

Jardine Was Entitled to the Claims of the Patent (Petitioners' Brief, pp. 10 and 11): Here again petitioners desert the grounds upon which this Court decided the case and the issue presented here and fly to a question of patentability—and this time to one never presented or discussed by any court in these causes.

The quick answer is that the structure in the cancelled claims was different from the structure of the allowed claims; the combinations are different from the structure and combinations of the cancelled claims and did not and could not operate as shown in Fig. F, for example, and could not maintain the minute clearance or other results of the Jardine piston and were failures where Jardine succeeded (here we interpret Gulick as this Court and Petitioners interpreted it).

Manifestly, the cited authority is not applicable since the Patent Office carefully adjudicated this question of the patentability of the allowed claims over the rejected claims, as did the parties to the interferences.

The rule applicable was stated by this Court in *Radio v. Radio,* 293 U. S. 1 and *Mumm v. Decker,* 301 U. S. 168, 171:

> "The issue of the patent is enough to show, until the contrary appears, that all the conditions under which a discovery is patentable in accordance with the statutes have been met. Hence, the burden of proving want of novelty is upon him who avers it. *Walker on Patents,* Sec. 116. Not only is the burden to make good this defense upon the party setting it up, *but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.'* Id., *Cantrell v. Wallick, supra; Coffin v. Ogden,* 18 Wall. 120, 124; *Barbed Wire Patent,* 143 U. S. 275, 284, 285; *Adamson v. Gilliland,* 242 U. S. 350, 353. *What must be so completely established by the defendant cannot be regarded as a part of the plaintiff's case which is to be set forth in his bill under the Equity Rule.*"

Certainly the presumption of validity will stand as against a claim of counsel unsupported by the record and made for the first time in a reply to a petition for a rehearing in the Court of final resort.

The Affidavits of Watts and Robertson Do Warrant a Different Decision or a Remand (Petitioners' Brief, pp. 12 and 13): We find no denial of what is said in these affidavits to the effect that there was no abandonment by Jardine of the thing that this Court said Jardine abandoned and upon which this Court's decision was predicated. There is no denial that Watts and Robertson are right in saying that the cancelled claim not only was not, but could not have been given the construction which this Court gave it. There is no denial that if given such construction it would not have read upon the disclosures of Long and Spillman upon which it was read from beginning to end in the Patent Office.

Petitioners' position is that this Court should read into Long and Spillman whatever reliefs were necessary to make

it possible to read those reliefs into the cancelled claims so as to make them coextensive with the patented claims. As we have pointed out, this would be violative of more rules of law and more facts than perhaps have ever been violated at one time before. Still, if it were done in order to cure the error that Jardine had abandoned something which he did not abandon, the claims would not be coextensive for the reason that still Long and Spillman could not operate like Jardine or get the Jardine results or achievements. They would still be failures where Jardine was a success. The Court is, therefore, invited to violate the law, the facts, and, in addition, the principles upon which the patent law was predicated, i.e., to reward the successful as against those who fail. Attempt is then made to draw a red herring across the trail by referring back to the flexible webs. The flexible web question was disposed of by this Court when it held that a patentee had the right to refer to his specification to interpret an element.

Counsel then state that the Court of Appeals did not find the relief to be "a distinguishing characteristic of the Jardine patent." The Court of Appeals found that the relief which the Court referred to as "retracted bosses" (top of page 9 in the Supplement to Petitioners' Brief), was an element of the claim just as was the flexible web; both findings were on the same basis. In our view, the question has been rather one of what the record shows than what the Court of Appeals said, because very often a Court does not say, in its opinion, all the things that are in the record. The record shows that the relief which Jardine employed (and which was not the common relief) is a distinguishing characteristic of the Jardine patent, and this is apparent from what we have said in connection with Figure F.

Again the authority cited is not applicable.

In the cited case *(Cosper v. Gold and Gold)*, the invention related to "a car heating apparatus." The car had

nothing to do with it except to be heated. The Court of Appeals of the District of Columbia held that under the circumstances it was not necessary to show the car. We would have an analogy in the instant case if somebody were to contend that Jardine should have shown the automobile which was to be operated by the engine in which his piston was used. An analogy in the cited case would have been present if some feature of the heating apparatus had not been disclosed in the patent. Counsel's position is a far cry from the recent decisions of this Court such, for example, as that in *Permutit v. Graver,* as well as in the first decision of this Court in this piston litigation. It would be difficult to find anything more inconsistent with the position of the petitioners throughout this litigation than the contention that a feature of structure not disclosed in a patent application could be read therein. Indeed, in *Permutit v. Graver* as it has been interpreted and contended for by the petitioners here, such a feature not only had to be shown in the drawing, but had to be described in the specification.

If, as plainly appears from the last ditch contention of petitioners, that a feature of structure must be read into the Long and Spillman disclosures (as well as into Hartog, another party to the interference showing no relief) in order to sustain this Court's decision here, then it is clear that remand is essential to the administration of justice, since, even if this error were overlooked and Jardine be held to have abandoned this rebuilt structure, evidence must be adduced to show identity between Jardine and such rebuilt structures.

With no evidence on the subject we are reluctant to assert our views and do so only that the Court may have the views of both counsel. **We assert with confidence that even if the Long, the Spillman and the Hartog pistons were supplied with the Jardine relief—they would be lacking in utility, would not be identical, or substantially identical**

with Jardine, and would be inoperative. Some of these things are so manifest as to be clear to the eye of the layman. If Jardine's relief were used in Spillman, there would be nothing to support the bosses; if Jardine's relief were used in Hartog, the two skirt parts (11) would be cut in two and half of each would fall away; if it were used in Long, the bosses, being supported at the inner ends only in the thin webs, would break the webs and there would be nothing to connect the head and skirt. In each case the engine would be ruined before it had been run a hundred yards.

If some other kind of relief were applied, regardless of failures of operations and results, neither Long nor Spillman would have such features as retracted bosses.

Our Positions Have Not Shifted (Petitioners' Brief, pp. 13-17) unless it can be said that we no longer urge such propositions as have been decided against us by this Court. For example, we are not urging here that Gulick and Maynard disclose the flexible webs to those skilled in the art because that question was decided against us. Nor are we urging that the Jardine patent covers certain pistons which the Court of Appeals decided it did not cover and on which question this Court denied Petition for Certiorari. We have never urged that a feature of structure could be read into a claim, much less into a patent application where it did not appear. We have always urged that a claim could be construed in the light of the specification and when so construed interpreted as reciting a property such as "flexible." There is neither inconsistency nor a shifting of position here.

Notwithstanding the red herrings that have been dragged across the trail in these causes, which might result in confusing one into believing that there is inconsistency between denying that *structure* cannot be read into a claim, on the one hand, and, on the other hand, that structure

already in a claim may be construed in the light of the specification, as possessing *properties* inherent in it, we have kept the line clear between these two contentions, for the first of which *McCarty v. Railroad Company* is authority, and for the other of which authority is found in such cases as *American v. Brogdex,* 283 U. S. 1 and the cases cited by this Court on page 5 of its recent decision in these causes. It is highly improper to read a feature of *structure* such as the "retracted bosses" or the "relief" into a claim, much less to modify a drawing to contain it, which did not otherwise contain it, on the one hand, and, on the other hand, to construe a claim reciting a web as having the *property* of flexibility inherent in that web in the light of the specification. These are the two rules that petitioners have confused and still confuse.

Interference Record Estoppel is a very different defense from file wrapper record estoppel; claim interpretation in the light of an interference record is a very different defense from the interpretation of the claim in the light of the file wrapper record. Even if everything the petitioners contend with respect to the necessity of pleading or not pleading file wrapper estoppel, and the sufficiency or insufficiency of the evidence thereon, were true, that would make no difference because both contentions as to pleadings and evidence relate to file wrapper record and not to interference records. There were claims in the Jardine application which were made and cancelled which were not counts of the interference and to which the file wrapper defenses apply. On these claims the file wrapper was sufficient evidence. However, as is shown by the affidavits of Watts and Robertson, this is not true of the counts that were in the Interference. *Indeed, the file wrapper which is the only evidence submitted by the petitioners is insufficient on the question of the interference defenses if it has any bearing upon the interference de-*

fenses at all. Likewise, any pleadings regarding the file wrapper defenses have nothing to do with the interference record defenses.

It results that even if everything defendants contend is true regarding the pleading and evidence on file wrapper estoppel (and not admitting it is true) there is no pleading that relates to either construction of claim or estoppel on the interference record, and not a bit of evidence on the interference record before the Court except the papers indicating that such an interference did exist.

Therefore, notwithstanding all of the contentions made by the petitioners, the cases should be remanded to include in the record at least the interference record if decision is to be based, as it is now based, upon estoppel, abandonment or claim construction which is, and can be only predicated upon the interference record.

"Additional Contentions in Respondents' Petition for Rehearing" (pp. 17-24 of Petitioners' Brief):

(c) It is true that we contended that the Ray Day piston infringed certain claims of the Jardine patent, but the Court of Appeals did not agree with us. Counsel contend that we should be bound by the construction of the claims which we urged in alleging that the Ray Day piston infringed. This would be to say that we could not now adopt the views of the Court of Appeals. It does not matter if this feature is old in some different combination from that of Jardine or the defendant.

(d) Claim 8 of the Jardine patent says that the piston is

> "provided with a longitudinal slit disposed between the ends of the webs."

This feature is not in the cancelled claim. While it is not important that this vertical slot should be right in the center, it is important that it should be between the ends of

the webs. Again it is immaterial that the feature is old in some other combination.

(e) Counsel are in error in saying that claims 8 and 11 do not recite the attachment of the web to the head flange. Claim 8 says that the webs are "integral with the flange" (R. p. 543, line 110). Claim 11 says the same thing (R. p. 544, line 17). This feature is not in the cancelled claims. Thus the allowed claims are narrower than the cancelled claims in that they contain, *inter alia*, the web attached to the head flange, the longitudinal slot located between the ends of the web, etc.

"Relative Breadth of Claims" (p. 21 of Petitioners' Brief): This Court did not say that these features were not in the Jardine patented claims. True, this Court said that the allowed claims did not recite "retraction of the skirt from the bosses," and while the claims did not use this language, they do recite this feature in the statement that the skirt is "cut away to expose the sides of the webs" (Claim 8), and "relieved adjacent said webs" (Claim 1) and "cut away to expose substantially all of the sides of the webs" (Claim 11). An additional feature of the allowed claims which is not in the cancelled claims was the *carrying of the bosses by the webs*, a very important feature, as is manifest from the examination of Figure F of this brief and from our discussion of the same.

There was no occasion to talk about radial flexibility in the term "slightly flexed radially" until after the opinion of this Court.

If we sought an interpretation of the Jardine claims broad enough to cover Exhibit CCC and have changed our position, it was because the Court of Appeals did not agree with us. Certainly the Courts will not construe a claim narrowly to hold non-infringement of Exhibit CCC and then turn around and hold the claim broad enough to cover Exhibit CCC to consider it upon the question of validity.

The discussion concerning a claim as a composite unit is a return to the question of patentability which is not now before the Court. All that counsel say, however, is that some combinations were not patentable. Nothing that is cited has any bearing upon the patentability of the Jardine combination which comes under the rule that a new combination of old elements is patentable where a new and meritorious result is achieved.

Counsel is as wild on the question of the law relating to supplemental oaths as he is on the effort to read structure into cancelled claims to make out a charge that something was abandoned that was not abandoned. Again the question of the supplemental oath applies to the combination and not to the elements.

Jardine's achievement of the small clearance is discussed in our Main Brief with ample references to the record to support the claim. We will not repeat them here, but ask the Court to consider the blue brief entitled "Respondents' Brief" on the main hearing if the Court wishes to consider this question on this record.

Combinations may not be sacred, but they are the rock-bottom basis of the patent law and its administration. When new, they are patentable regardless of the antiquity of their elements (*Expanded Metal v. Bradford, supra*); they are separate legal entities from their elements and from each other (*Leeds & Catlin v. Victor*, 213 U. S. 318); under the statute they define the invention (*Altoona v. Tri-Ergon*, 294 U. S. 477); they define invention independently of each other (294 U. S. 477); they measure the metes and bounds of the invention; the prosecution of the applications of the patents in suit and all other patents and the consideration thereof has been based upon these legal principles.

Patent Pool: Return is again made to the patent pool question; this and the incorrect allegations regarding the

same lead to the conviction that petitioners regard this defense as their real defense (Petitioners' Brief, pp. 10-11). There is something sinister about resort in every brief and argument presented by the petitioners to the patent pool with exaggerated and incorrect contentions to build it up, as if such things are to be weighed in the scales. We deem it unnecessary for us to make other reply than these notes.

(Appendix Petitioners' Brief, pp. I-XIV): Here are presented questions not brought before this Court by the certiorari: The briefs from which the excerpts are taken are not before this Court; this Court is not supplied with the evidence, the complete arguments or even the context of the excerpts. Indeed, this Court refused our petition for certiorari on most of the questions to which the excerpts relate.

If the contentions made in the appendix regarding patentability are proper here, they are mere repetitions of what was in petitioners' briefs on the main appeal in this Court and are answered in our briefs there and in the opinion of the Court of Appeals.

The Matter of Pleading: Our statement that the propositions upon which the Court based its opinion had not been pleaded as defenses at the outset did not particularly insist upon a lack of pleading as now controlling; it was a part of the history of the case, to show that this Court was asked to sustain a defense that had never been presented in any way to any court below,—which the bar has been taught this Court will not do.

Conclusion: Without dispute the allowed claims then recite at least the following features not in the cancelled claims:

(1) the cut away or relieved part of the skirt or Jardine relief or the retraction of the skirt from the bosses, as one wishes to call it,

(2) the location of the vertical slots between the ends of the webs,

(3) the connection of the webs to the head-flange,

(4) the carrying of the bosses by the webs.

These features were not in the cancelled claims when they were cancelled; if read *nunc pro tunc* into the cancelled claims (in violation of the rule in *McCarty v. Lehigh, supra*) the claims could not have been made by the other parties to the interference.

Rebuilding Long and Spillman to include Jardine's relief and then reading the Jardine relief in the cancelled claims would be insufficient, for, other of these elements and features would have to be incorporated in each of the Long, Spillman, Hartog and Day pistons and then read into the cancelled claims *nunc pro tunc*. Elements 1, 2 and 3 must be read into Spillman; elements 1, 2 (some are not) and 3 into Long; elements 1, 2, 3 and 4 into Hartog. Day is not before the Court. Moreover, some of these other elements and features would have to be read into some of these pistons and not in others. Somebody would have to make the selections and the incorporations; when the job was finished all would be *inoperative* and useless; all would be pistons which their inventors never conceived or designed.

Petitioners' resort to the request that elements and features be read into Long and Spillman emphasizes the necessity of remanding the causes, for, how, without evidence on the subject, is the Court to know that such changes as are proposed, if permissible, will not make the Long and Spill-

man (as well as Hartog and Day) inoperative, useless or different in substance from the disclosure of these applicants or otherwise inapplicable?

Respectfully submitted,

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